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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,656	07/09/2003	Takashi Yoshizawa	763-37	9316
28249	7590	01/30/2006	EXAMINER	
DILWORTH & BARRESE, LLP			MOHANDESI, JILA M	
333 EARLE OVINGTON BLVD.			ART UNIT	PAPER NUMBER
UNIONDALE, NY 11553			3728	

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/615,656	Applicant(s) YOSHIZAWA, TAKASHI	
	Examiner Jila M. Mohandesi	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16, 17 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-14, 16, 17, and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application contains claim 3 drawn to an invention nonelected without traverse in Paper filed on 1/31/05. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Accordingly, claims 1-2 and 4-14, 16-17 and 19-22 will be further examined on the merits.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Taormina [6,170,651].

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Taormina discloses in Figs 1-2, an eyeglass case 10 comprising: an upper cover [first closed end 26], a lower cover [second closed end 30], a button 46 which is secured to the lower cover and a rotating member [pivot point 50] which is secured to a contact portion [Fig 1] between the upper cover and the lower cover, wherein said rotating member is arranged such that when pushing the button for release, a spring 52 in the rotating member moves to slowly open the upper cover upwardly away from the lower cover and allow contents within the case to be removed in a single step by the same hand. By pushing on button 52 while tilting the eyeglass case, you can remove the eye glasses in a single step by the same hand by forcing the eye glasses out of the case.

Additionally, Taormina discloses a button-securing portion/ upper lock member [opposing ledge 48] situated upon upper cover as recited in claim 10, lower lock member [latch 44] situated upon lower cover as recited in claim 11.

Since the device disclosed in the reference includes all of the structural elements of the claims it is presumed to be inherently capable of all the claimed functions including the ability to be opened with just a single hand by depressing the button and be removed in single step by the same hand.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 8-9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taormina.

Taormina discloses most of the elements of these claims as stated above but for two rotating members respectively situated on lateral ends of the eyeglass case. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Taormina with a second rotating members in order to have stronger attachment, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

With respect to claim 21, the cylindrical eyeglass case of Taormina is considered to be oblong inasmuch as it deviates from a circle by elongating in one dimension. The rotating member is positioned along one of said longer sides of the eyeglass case, see Figure 2 embodiment which clearly shows the rotating member being positioned along one of said longer sides, and said button positioned adjacent the other of said longer side. Furthermore it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

With respect to the button is situated on the upper cover: changing the location of the button from the proximate location shown by Taormina to a location on the upper cover, absent any criticality, is also considered an obvious modification of Taormina's apparatus that a person having ordinary skill in the art at the time the invention was made would be able to provide using routine experimentation since the courts have held that there is no invention in shifting the position of a structure to a different position if the

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operation of the device would not be thereby modified. In re Japikse, 86 USPQ 70 (CCPA 1950).

6. Claims 2, 4-7, 13-14, 16-17, 19-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taormina [6,170,651] in view of Lin [US 2003/0201265 A1].

Taormina discloses most of the elements of these claims as stated above.

Taormina does not disclose a support spindle wherein oil is sealed in the support spindle as recited in claim 2, to claim 4, wherein the outer housing is constituted by an outer cylindrical frame with the support spindle structured and arranged to fit into the frame along an inner circumferential wall thereof as recited in claim 5. Additionally, Taormina does not disclose protrusions extending from a lateral end wall of the outer cylindrical frame and inner lateral surface of the support spindle as recited in claim 6, button is situated on the upper cover as recited in claims 9 and 17.

Lin teaches the concept of providing a container to hold items having a pivoting cover 20 with two support spindle [pivot element 30] wherein oil [subsection 0041] is sealed in the support spindle, wherein the outer housing is constituted by an outer cylindrical frame [semi-sleeves 23 and 24] with the support spindle structured and arranged to fit into the frame along an inner circumferential wall thereof, protrusions extending from a lateral end wall of the outer cylindrical frame and inner lateral surface of the support spindle [subsection 0039]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the pivoting connection of device of Taormina with the slow pivoting connection as taught by Lin in order to reduce the noise while opening and closing the eyeglass case.

With respect to button is situated on the upper cover: changing the location of the button from the proximate location shown by Taormina to a location on the upper cover, absent any criticality, is also considered an obvious modification of Taormina's apparatus that a person having ordinary skill in the art at the time the invention was made would be able to provide using routine experimentation since the courts have held that there is no invention in shifting the position of a structure to a different position if the operation of the device would not be thereby modified. In re Japikse, 86 USPQ 70 (CCPA 1950).

With respect to claim 22, oil is positioned throughout an interior of said rotating member (external tube 32, internal tube 31 and spring 33) and about the spring positioned therein, i.e. the oil is between the external tube 32 and internal tube 31, which in turn is about the spring.

Response to Arguments

3. Applicant's arguments filed November 14, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Contrary to applicant's argument it is possible to both open the eyeglass case of Taormina remove the eyeglasses in a single step and with the same hand by pushing on button 52 while tilting the eyeglass case, which will inherently force the eyeglasses out of the eyeglass case.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

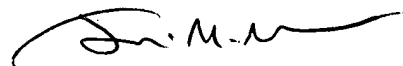
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
January 24, 2006